

REMARKS

Applicants would like to take this opportunity to thank Examiner Schnizer for meeting with applicants' representative for an in-person interview on March 8, 2005. The contents of the enclosed Response and Amendment are in accordance with what was discussed and agreed to in the interview.

Upon entry of the above amendments, claims 5-13 and 15-29 will be pending in the captioned application. The claims have been amended to more clearly define the claimed invention and to address the rejections of the claims.

Applicants respectfully submit that neither the amendments to the claims, nor new claims 18-29, add any new matter within the meaning of 35 U.S.C. §132. Entry is therefore respectfully requested.

Upon entry of the above amendment, there will be a total of twenty-four claims pending in this application, 5 of which are independent. Accordingly, applicants submit herewith a check in the amount of \$600.00 for the additional claims fees. (2 independent claims in excess of three = \$400.00; 4 dependent claims in excess of twenty = \$200.00).

1. Rejection of claims 5, 10, 11 and 16 under 35 U.S.C.

§102(a)

The Official Action states the following, in relevant part:

Claims 5, 10, 11 and 16 are rejected under 35 U.S.C. 102(a) as anticipated by Borron et al. This rejection is set forth in the prior Office Action, mailed 6/22/04.

RESPONSE

Applicants respectfully traverse this rejection. The Examiner has failed to establish a *prima facie* case of anticipation under 35 U.S.C. §102(a) because the cited reference fails to teach each and every element of the presently pending claims.

The test for anticipation is whether each and every element as set forth is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

However, solely to remove the grounds for the present rejection, and to obtain a Notice of Allowance, applicants have amended claim 5 to recite "A lipid-free pharmaceutical composition in powder form comprising...".

As discussed in the interview, and as agreed to by the Examiner, applicants again respectfully point out to the Examiner that the Borron et al. reference does not disclose a lipid-free pharmaceutical composition in powder form comprising rSP-A and a suitable carrier therefore, as presently claimed in claim 5. Thus, each and every element of the presently pending claim 5 is not found in the Borron et al. reference, as required by *Verdegaal Bros. v. Union Oil Co. of California*. Accordingly, Borron et al. does not anticipate present claims 5-17.

As such, applicants respectfully request that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §102(a).

**2. Rejection of claims 6-9, 13 and 15-17 under 35 U.S.C. §112,
1st paragraph**

The Official Action states, in relevant part:

Claims 6-9, 13, 15, 16 and 17 are rejected under 35 U.S.C. 112, 1st paragraph because the specification, while enabling for methods of treatment of pulmonary infection or inflammation using recombinant SP-A...does not reasonably provide enablement for methods of preventing pulmonary infection or inflammation..

RESPONSE

Applicants respectfully traverse this rejection. However, solely to obtain a Notice of Allowance, applicants have deleted the phrase "preventing or" from claims 6, 8, 13, 15, 16 and 17, rendering the basis for this rejection moot.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §112.

3. Objection to claim 12

The Official Action states that claim 12 is objected to but would be allowable if rewritten into independent format.

Applicants thank the Examiner for this indication of allowable subject matter. Claim 12 has not been amended at this time, however, because applicants respectfully submit that the amendments to claim 5, from which claim 12 depends, remove the basis for this objection.

Further, applicants respectfully point out to the Examiner that, in order to obtain the full scope of allowable claim 12, applicants have submitted herewith new claim 23. In particular, applicants respectfully note that claim 23 does not contain the "in powder form" limitation incorporated into amended claim 5.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the objection to claim 12.

CONCLUSION

In view of the foregoing, applicants respectfully request the Examiner to allow all claims pending in this application.

If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

Respectfully submitted,

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Date: May 18, 2005
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